

REMARKS

After entry of this Amendment, claims 2-8 and 10-17 will be pending in this Patent Application, with claims 10-15 having been withdrawn from consideration pursuant to a previous restriction requirement. By this Amendment, Applicant has cancelled independent claims 1 and 9 and has replaced them with new independent claims 16 and 17, which better comport with typical U.S. claim drafting practice. Additionally, Applicant has amended claims 2-6 and 10-15 to depend from the new independent claims and to improve readability. No new matter has been added. Additionally, Applicant does not believe that the claim amendments are narrowing in any way. Reconsideration and allowance of this patent application are respectfully requested in view of the above amendments and the following remarks.

Comments on the Restriction Requirement

The Office Action formally sets forth a restriction requirement that was conveyed verbally to Applicant's attorney on January 15, 2004. The restriction requirement groups the claims into group 1, including claims 1-8, allegedly "drawn to a metal mask structure classified in class 428, subclass 209" and claims 9-15, "drawn to a method for manufacturing a metal mask structure." The Examiner alleges that the two groups of claims recite distinct inventions, specifically because "the product as claimed can be made by different process." Applicant provisionally elected group 1, claims 1-8, for examination on the merits. Applicant now ratifies that election and respectfully traverses the restriction requirement.

Applicant respectfully disagrees with the example given in support of Examiner's assertion that "the product as claimed can be made by different process." Applicant notes that original claims 1 and 9 recite welding, as do new independent claims 16 and 17. Yet the

Examiner's assertion of an alternative process for producing the apparatus of claim 1 refers to "applying heat and pressure to bond them together." The process suggested by the Examiner, whatever it may be, is not welding; therefore, the Examiner has clearly ignored the process as claimed.

Furthermore, regardless of what the Examiner may assert with respect to the apparatus and process claims, Applicant respectfully submits that the search and examination of both groups can be made without a serious burden. MPEP § 803 clearly states that "if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicant submits that the policy set forth in MPEP § 803 should apply to the present application in order to avoid extra cost and duplicative examination. For the sake of convenience and expedience, Applicant has amended the withdrawn claims, as well as those that are currently under consideration in this Response.

For at least the foregoing reasons, Applicant respectfully requests that the restriction requirement be withdrawn and that all of the claims be examined on the merits.

35 U.S.C. § 103 Claim Rejections

Claims 1-8 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Griffin, U.S. Patent No. 3,769,908. Because claim 1 is cancelled, the rejection is technically moot with respect to that claim. However, Applicant respectfully traverses with respect to pending claims 2-8, and will explain why the rejection should not be extended to new claim 16, from which those claims have been amended to depend.

In order for a prior art reference or combination of references to render a claim obvious, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference or references, when combined, must disclose or suggest all of the claim limitations. The motivation to modify the prior art and the reasonable expectation of success must both be found in the prior art and not based upon a patent applicant's disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 16, which corresponds to original claim 1, recites, *inter alia*, "a metal mask having a concave part formed in a first surface which comprises the opposite side of a frame-contacting surface" and that "the metal mask and the support frame are welded together within the concave part." (Similar features were recited in claim 1.) Applicant respectfully submits that Griffin does not disclose or suggest at least those features.

Instead, Griffin states at column 2, lines 45-47, that "the frame 14 has a groove 16 around the periphery, into which the edges of this screen are forced and locked in place by locking strips 18." Thus, in Griffin, the peripheral frame has a groove, not the screen, and the fit between the two components is a friction or interference fit. (Note that Applicant does not necessarily concede that the frame and screen of Griffin read on the elements recited in claim 16.)


Moreover, Applicant respectfully submits that it would not have been obvious to modify the screen of Griffin to include a groove, because there would have been no reason or motivation to do so; the Griffin structures are secured together very differently than are the structures recited in claim 16. Specifically, claim 16 recites a mask and support frame that are welded, whereas Griffin explicitly discloses "locking strips," as described in the passage quoted above, and does

not disclose or suggest welding. Thus, for the sake of argument, even if the Griffin screen was modified to include a groove, the result would still not include all of the features recited in claim 16 because Griffin does not disclose or suggest welding. Accordingly, Applicant respectfully submits that independent claim 16, and the claims that depend from it, are not rendered obvious by Griffin. Therefore, Applicant respectfully requests that rejection be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicant submits that all the claims are allowable over the cited references and that the application itself is in condition for allowance. The Examiner is respectfully requested to pass this application to issue. If needed, the Examiner is invited to contact the undersigned at the telephone number listed below. Applicant hereby makes a written conditional petition for an extension of time, if one is required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 23-1951.

Respectfully submitted,


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